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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,681	07/08/2003	Jung Chung Lai	0EKM-104478	9816
30764 7590 06/27/2008 SHEPPARD, MULLIN, RICHTER & HAMPTON LLP 333 SOUTH HOPE STREET 48TH FLOOR LOS ANGELES, CA 90071-1448				
EXAMINER AUGHENBAUGH, WALTER				
ART UNIT		PAPER NUMBER		
1794				
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06/27/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/615,681

**Applicant(s)**

LAI ET AL.

**Examiner**

WALTER B. AUGHENBAUGH

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 2, 2008 has been entered.

***WITHDRAWN OBJECTIONS***

2. All objections of record in the previous Office Action mailed November 2, 2007 have been withdrawn due to Applicant's arguments and amendments in the specification in the submission filed on May 2, 2008

***WITHDRAWN REJECTIONS***

3. All rejections of record in the previous Office Action mailed November 2, 2007 have been withdrawn due to Examiner's reconsideration of the rejections.

***NEW REJECTIONS***

***Claim Rejections - 35 USC § 103***

4. Claims 1, 4-7 and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (USPN 5,932,336) in view of Fischer et al. (USPN 4,243,576).

5. In regard to independent claim 1, Allen et al. teach an article of footwear (shoe, item 10, Fig. 1, 2 and 6) comprising an upper, item 12, and a sole, item 14, wherein the sole has an outsole for directly contacting a ground surface (outsole, item 60, Fig. 6) (col. 5, lines 39-41 and col. 6, lines 64-67). Allen et al. teach that the article of footwear comprises at least one element

(frame, item 50) (col. 6, lines 22-45, Fig. 4-6). Allen et al. teach that the outsole, item 60, comprises a material (which corresponds to Applicant's claimed "second material of the outsole") that is less hard than the at least one element (frame, item 50) because Allen et al. that the material of the frame, item 50, is harder than the material of the outsole, item 60 (col. 6, lines 29-38 and col. 6, line 64-col. 7, line 13). The material of the outsole, item 60, of Allen et al. is less dense than the at least one element (frame, item 50) because the material of the outsole, item 60, of Allen et al. is softer than the material of the frame, item 50 (col. 6, lines 29-38 and col. 6, line 64-col. 7, line 13), and therefore serves as a cushioning material (col. 7, lines 14-17) and provides more of a cushioning effect than frame, item 50, provides in the combination of the frame and outsole (col. 7, lines 14-17), so the density of the outsole, item 60, is necessarily less than that of the frame, item 50, since the cushioning outsole is more easily compressed (there are necessarily spaces, that are either visible to the naked eye or not, that exist in the cushioning material which allow the cushioning material to compress when a sufficient force is applied to the cushioning material, which render the cushioning material less dense than the material of the frame, which is not a cushioning material). The material of the outsole, item 60, is compatible for compression molding with the at least one element (frame, item 50) because the outsole and the frame coexist in the same final product (Fig. 4-6). The recitation "compression molded with the outsole" (line 4) is a method limitation that has not been given patentable weight since the method of forming the article is not germane to the issue of patentability of the article itself. The recitation "compression molded with" (line 4) does not recite any structural or compositional limitations of the claimed final product or of any components of the claimed final product. Allen et al. teach that the frame is preferably comprised of a polyurethane or thermoplastic

polyurethane (col. 6, lines 29-32) and that the frame is comprised of spike (cleat) receptacles (col. 6, lines 23-29).

Allen et al. fail to teach that the frame is formed from a material comprising at least 45% ethylene vinyl acetate, approximately 30% polyene elastomer and approximately 20% synthetic rubber and the frame is not damaged during a bending test under the claimed conditions.

Fischer et al., however, disclose a composition that is suitable for compression molding (col. 2, lines 14-18) that comprises about 40 to 70% by weight of ethylene vinyl acetate and two elastomeric materials (elastomeric materials are rubbers), such as ethylene propylene rubber, ethylene propylene diene rubber and other rubbers (col. 2, line 22-col. 3, line 8). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the blend of ethylene vinyl acetate, a polyene elastomer and another rubber as the material of the frame of the compression molded outsole of Allen since the blend taught by Fischer et al. is a suitable elastomeric material for compression molding as taught by Fischer et al. Since Fischer et al. teach the blend claimed by Applicant, using the blend of Fischer et al. necessarily results in a frame that is not damaged during a bending test under the claimed conditions.

In regard to claim 4, Allen et al. teach that the second material of outsole, item 60, comprises thermoplastic polyurethane or a thermoplastic polyurethane/thermoplastic rubber blend (which is a rubber and a thermoplastic polyurethane) (col. 6, line 66-col. 7, line 3).

In regard to claim 5, Allen et al. teach that the second material of outsole, item 60, comprises a thermoplastic polyurethane/thermoplastic rubber blend and therefore both a rubber and a thermoplastic polyurethane (col. 6, line 66-col. 7, line 3).

In regard to claim 6, the at least one element (frame, item 50) of Allen et al. is outwardly visible on the sole (Fig. 6).

In regard to claim 7, the at least one element (frame, item 50) of Allen et al. comprises a plurality of elements (the portion of frame, item 50, that corresponds to sections 30, 32 and 34 in Fig. 2 and the section consisting of two spikes, 40d and 40g, in section 32 in Fig. 2: comparison of the location of frame 50 in Fig. 6 with Fig. 2 makes it clear that spikes 40a-q sit on top of frame 50 (col. 5, line 63-col. 6, line 4 and col. 6, line 11-22), and both of these elements of the plurality of elements are outwardly visible on the sole (Fig. 2).

In regard to claim 10, the at least one element (frame, item 50) of Allen et al. provides torsional reinforcement for the sole since Allen et al. teaches that the combination of outsole 60 and frame 50 provides good crosswise stability (col. 7, lines 14-17).

In regard to independent claim 11, Allen et al. teach an article of footwear (shoe, item 10, Fig. 1, 2 and 6) comprising an upper, item 12, and a sole, item 14, wherein the sole has an outsole for directly contacting a ground surface (outsole, item 60, Fig. 6) (col. 5, lines 39-41 and col. 6, lines 64-67). Allen et al. teach that the article of footwear comprises at least one element (frame, item 50) (col. 6, lines 22-45, Fig. 4-6). Allen et al. teach that the article of footwear comprises at least one cleat receptacle (spike sockets/receptacles, item 54) (frame, item 50) (col. 6, lines 22-29, col. 7, lines 44-52 and Fig. 6). Allen et al. teach that the outsole, item 60, comprises a material (which corresponds to Applicant's claimed "second material of the outsole") that is less hard than the at least one element (frame, item 50) because Allen et al. that the material of the frame, item 50, is harder than the material of the outsole, item 60 (col. 6, lines

29-38 and col. 6, line 64-col. 7, line 13). The material of the outsole, item 60, of Allen et al. is less dense than the at least one element (frame, item 50) because the material of the outsole, item 60, of Allen et al. is softer than the material of the frame, item 50 (col. 6, lines 29-38 and col. 6, line 64-col. 7, line 13), and therefore serves as a cushioning material (col. 7, lines 14-17) and provides more of a cushioning effect than frame, item 50, provides in the combination of the frame and outsole (col. 7, lines 14-17), so the density of the outsole, item 60, is necessarily less than that of the frame, item 50, since the cushioning outsole is more easily compressed (there are necessarily spaces, that are either visible to the naked eye or not, that exist in the cushioning material which allow the cushioning material to compress when a sufficient force is applied to the cushioning material, which render the cushioning material less dense than the material of the frame, which is not a cushioning material). The material of the outsole, item 60, is compatible for compression molding with the at least one element (frame, item 50) because the outsole and the frame coexist in the same final product (Fig. 4-6). The cleat receptacles (spike sockets/receptacles, item 54) are accessible for attachment of a non-metal cleat (col. 9, lines 9-22 and Fig. 6). The recitation "compression molded with the outsole" (line 4) is a method limitation that has not been given patentable weight since the method of forming the article is not germane to the issue of patentability of the article itself. The recitation "compression molded with" (line 4) does not recite any structural or compositional limitations of the claimed final product or of any components of the claimed final product. Allen et al. teach that the frame is preferably comprised of a polyurethane or thermoplastic polyurethane (col. 6, lines 29-32) and that the frame is comprised of spike (cleat) receptacles (col. 6, lines 23-29).

Allen et al. fail to teach that the frame is formed from a material comprising at least 45% ethylene vinyl acetate, approximately 30% polyene elastomer and approximately 20% synthetic rubber and the frame is not damaged during a bending test under the claimed conditions.

Fischer et al., however, disclose a composition that is suitable for compression molding (col. 2, lines 14-18) that comprises about 40 to 70% by weight of ethylene vinyl acetate and two elastomeric materials (elastomeric materials are rubbers), such as ethylene propylene rubber, ethylene propylene diene rubber and other rubbers (col. 2, line 22-col. 3, line 8). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the blend of ethylene vinyl acetate, a polyene elastomer and another rubber as the material of the frame of the compression molded outsole of Allen since the blend taught by Fischer et al. is a suitable elastomeric material for compression molding as taught by Fischer et al. Since Fischer et al. teach the blend claimed by Applicant, using the blend of Fischer et al. necessarily results in a frame that is not damaged during a bending test under the claimed conditions.

In regard to claim 12, Allen et al. teach that the second material of outsole, item 60, comprises thermoplastic polyurethane or a thermoplastic polyurethane/thermoplastic rubber blend (which is a rubber and a thermoplastic polyurethane) (col. 6, line 66-col. 7, line 3).

In regard to claim 13, Allen et al. teach that the second material of outsole, item 60, comprises a thermoplastic polyurethane/thermoplastic rubber blend and therefore both a rubber and a thermoplastic polyurethane (col. 6, line 66-col. 7, line 3).

In regard to claims 14 and 15, the at least one element (frame, item 50) of Allen et al. comprises a plurality of elements (the portion of frame, item 50, that corresponds to sections 30,



32 and 34 in Fig. 2 and the section consisting of two spikes, 40d and 40g, in section 32 in Fig. 2: comparison of the location of frame 50 in Fig. 6 with Fig. 2 makes it clear that spikes 40a-q sit on top of frame 50, col. 5, line 63-col. 6, line 4 and col. 6, line 11-22), and both of these elements of the plurality of elements includes a cleat receptacle, item 54 (Fig. 2 and 6).

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (USPN 5,932,336) in view of Fischer et al. (USPN 4,243,576) and in further view of McKay et al. (USPN 5,869,591).

In regard to claim 3, Allen et al. and Fischer et al. teach the article as discussed above in regard to claim 1. While Allen et al. teach that the outsole 60 is formed of ethylene vinyl acetate (EVA) (col. 7, lines 12-13), Allen et al. fail to teach that the outsole 60 comprises a blowing agent. McKay et al., however, discloses that the composition in the form of shoe soles (and therefore for use as a material in shoes), athletic sponge pads and heat insulation (col. 54, lines 32-34) is a foamed composition (col. 54, lines 30-32), and that a blowing agent may be used to form the foamed composition (col. 24, lines 5-19). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a blowing agent to have foamed the EVA of the outsole 60 of the article taught by Allen et al. and Fischer et al. since a foamed EVA composition (col. 20, lines 58-65) is a well known composition for use in formation of athletic shoes as taught by McKay et al.

7. Claims 8, 9, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (USPN 5,932,336) in view of Fischer et al. (USPN 4,243,576) and in further view of Safdie (USPN 5,771,605).

Allen et al. and Fischer et al. teach the article of footwear as discussed above in regard to claims 1 and 11.

Allen et al. and Fischer et al. fail to teach that the at least one element (frame, item 50) of Allen et al. includes a foil layer that is outwardly visible on the sole as claimed in claims 8 and 16, or that the at least one element (frame, item 50) of Allen et al. includes an electroplated member that is outwardly visible on the sole as claimed in claims 9 and 17.

Safdie, however, in regard to claims 8 and 16, discloses an image-display system for apparel such as shoes (col. 1, lines 11-25) that displays such images as foil images (col. 2, lines 47-56). Safdie discloses that the display panel, item 32, is attached to a metal plate, item 22, (col. 5, lines 7-9 and Fig. 1 and 12) which also may be considered a foil since Safdie teaches that it is cut from a sheet of metal (col. 5, lines 36-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an image-display system that comprises a foil layer of Safdie that is suitably sized on an exposed (outwardly visible) portion of the at least one element (frame, item 50) since it is well known to apply an image-display system that comprises a foil layer such as that of Safdie on a shoe in order to display an image that is desired to be displayed for the particular desired end use of the image (for example, a label) as taught by Safdie.

Safdie, however, in regard to claims 9 and 17, discloses an image-display system for apparel such as shoes (col. 1, lines 11-25) that displays such images as foil images (col. 2, lines

47-56). Safdie discloses that the display panel, item 32, is attached to a metal plate, item 22, (col. 5, lines 7-9 and Fig. 1 and 12), where the plate 22 is made of, or coated with, an electroplated metal (col. 5, lines 53-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an image-display system that comprises an electroplated member of Safdie that is suitably sized on an exposed (outwardly visible) portion of the at least one element (frame, item 50) since it is well known to apply an image-display system that comprises an electroplated member such as that of Safdie on a shoe in order to display an image that is desired to be displayed for the particular desired end use of the image (for example, a label) as taught by Safdie.

#### ***Response to Arguments***

8. Applicant's arguments regarding the 35 U.S.C. 103 rejection of record in the previous Office Action mailed November 2, 2007 are moot due to the withdrawal of the rejections in this Office Action.

#### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is (571) 272-1488. While the examiner sets his work schedule under the Increased Flexitime Policy, he can normally be reached on Monday-Friday from 8:45am to 5:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Walter B Aughenbaugh /  
Examiner, Art Unit 1794

6/23/08